

fastened to a semi-rigid shaft 14 having a conduit element or flexible tube 16 extending therethrough. Col. 4, lines 33-35. Needle 12 is fastened at one end of shaft 14 in a conventional way. Col. 4, lines 47-48. Flexible tube 16 is fastened to shaft 14 in a conventional way. In this fashion, tube 16 and shaft 14 provide a conduit from the forcing mechanism such as a syringe (not shown) to needle 12. Col. 4, lines 56-57. FIGS. 7 and 8 show a tool 10 used in a representative urological operative instrument 30, namely a resectoscope. Instrument 30 includes an optical assembly 62 having a telescope tube 64 with an eyepiece 66 at its proximate end and an objective lens 68 at its distal end. A light source (not shown) may be connected at nipple 70 for transmission of light through a bundle of fiber-optic rods 72 to illuminate the field of view. Optical assembly 62 is attached to the working element 74 with thumbscrew 76. Sheath 78 is frictionally fastened to working element 74 and released by turning thumbscrew 80. Sheath 78 is tubular and includes telescope tube 64 and provides additional space for the passage of accessory tools such as tool 10. Col. 6, lines 27-41. To install a tool 10 in resectoscope 30, instrument 30 may be in or out of the patient. Tool 10 is inserted in a retrograde fashion by passing needle 12 and shaft 14 through header 86. With end portion 34 between header 86 and body 84, shaft 14 is bent at slot 22 so that it extends away from body 84 and may be connected to luer lock 106 for connection to a syringe. The portion of shaft 14 within sheath 78 is then moved toward body 84 so that end portion 34 extends into passage 104 allowing end portion 34 to be clamped by clamping mechanism 28. By extending tool 10 into passage 104 so that end portion 34 of end piece 18 contacts connector 42, tool 10 may be used as an electrode when connector 42 is appropriately connected to an electrical energy source. Tool 10 is now operable by instrument 30 simply by operating working element 74 and moving the tip of needle 12 longitudinally within the objective field of view of instrument 30. Col. 6, line 66 to Col. 7, line 15.

The combination of Claim 14 is not anticipated by Orandi. Contrary to the assertion of the Examiner, Orandi does not disclose an assembly as called for in Claim 14 having a cannula for slidably receiving a needle so as to guide said needle. The Examiner refers to telescope tube 64 of the Orandi device as being a cannula. As noted above, instrument 30 of the Orandi device includes an optical assembly 62 having a telescope tube 64 with an eyepiece 66 at its proximate end and an objective lens 68 at its distal end. A light source (not shown) may be connected at nipple 70 for transmission of light through a bundle of fiber-optic rods 72 to illuminate the field

of view. See Col. 6, lines 33-35. There is no disclosure in Orandi of telescope tube 64 slidably receiving needle 12 so as to guide said needle, as called for in Claim 14. Instead, telescope tube 64 is described as having an objective lens 68 at its distal end. In FIG. 7 of Orandi, the bundle of fiber-optic rods 72 also appears to be within telescope tube 64. FIG. 7 of Orandi further shows that needle 12 is not within telescope tube 64, but instead extends alongside the tube 64 within sheath 78 of resectoscope 30.

Nor does Orandi disclose means for interlocking said assembly, which under Claim 14 includes a needle having a hollow core and a cannula for slidably receiving said needle, to the housing of said endoscopic surgical instrument so as to extend said needle and cannula through the conduit of said endoscopic surgical instrument. More specifically, and as discussed above, Orandi does not disclose means for interlocking an assembly having telescopic tube 64 with needle 12 slidably received therein to sheath 78 so as to extend said needle and tube 64 through the conduit of said sheath 78.

Applicants respectfully submit that Orandi does not disclose the combination of Claim 14 and hence does not anticipate Claim 14. Accordingly, the rejection of Claim 14 under 35 U.S.C. §102(b) should be withdrawn.

Claims 15-23 depend from Claim 14 and are patentable for the same reasons as Claim 14 and by reason of the additional limitations called for therein.

Claim 24 is not anticipated by Orandi for the same reasons as discussed above with respect to Claim 14. In this regard, Orandi does not disclose an elongate probe member having a longitudinal axis and at least one passageway, a guide cannula mounted in the at least one passageway of the elongate probe member, the guide cannula having an opening in the distal extremity and a lumen extending from the proximal extremity to the opening in the distal extremity, a needle slidably disposed in the lumen of the guide cannula. As stated above, needle 12 of the Orandi device is not slidably disposed in telescope tube 64 but instead extends alongside the telescope tube 64 in sheath 78 of resectoscope 30. In view of the foregoing, Applicants respectfully submit that rejection of Claim 24 under 35 U.S.C. §102(b) should be withdrawn.

Claims 25-30 depend from Claim 24 and are patentable for the same reasons as Claim 24 and by reason of the additional limitations called for therein.

Claims 14-30 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over all claims in U.S. Patent Nos. 6,102,886, 5,848,986, 5,531,677 and 5,409,453. A terminal disclaimer with respect to such patents will be forthcoming in a supplemental amendment.

In view of the foregoing, it is respectfully submitted that the claims of record are allowable and that the application should be passed to issue. Should the Examiner believe that the application is not in a condition for allowance and that a telephone interview would help further prosecution of this case, the Examiner is requested to contact the undersigned attorney at the phone number below.

Respectfully submitted,

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